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OFFICE OF PETITIONS

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In re Application of
Menard, et al.
Application No. 08/844,267
Filed: April 18, 1997
Attorney Docket No. 148-1123

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ON PETITION

This is a decision on the "Petition to withdraw Abandonment under 37 CFR 1.181(a) and MPEP 711.03(c), or in the alternative, Petition to Revive Abandoned Application Due to Unavoidable delay under 37 CFR 1.137(a), or in the alternative, petition to revive Abandoned Application Due to Unintentional Delay under 37 CFR 1.137(b).", filed November 8, 1999.

The petition under 37 CFR 1.181(a) is **DISMISSED**.

The petition under 37 CFR 1.137(a) is also **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to reply to the "Notice of Allowability" mailed April 9, 1999, requiring formal drawings. The notice set an shortened statutory period for reply of three months from its mailing date. A response to the Notice of Allowability was not received within period set for reply. The application became abandoned on July 10, 1999. A Notice of Abandonment was mailed on November 8, 1999.

TREATMENT UNDER 37 CFR 1.181(a)

Petitioner maintains that the holding of abandonment should be withdrawn because the examiner failed to indicate on the summary sheet for the Notice of Allowability that formal drawings were required, although the requirement for formal drawings was made in the accompanying text of the Notice of Allowability. Petitioner's argument is not persuasive. A petition to withdraw the holding of abandonment is reserved for those instances when an application is improperly placed in an abandoned status by the USPTO. In this case, a requirement for formal drawings was made in the Notice of Allowability and no response was received within the period set for reply. The application was properly abandoned, accordingly. The petition to withdraw the holding of abandonment is not appropriate where, as in this case, an application is properly abandoned but said abandonment was unavoidable or unintentional. The petition to withdraw the holding of abandonment is dismissed.

TREATMENT UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”¹

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”²

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”³

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁴

¹*Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), *aff’d without opinion (Rule 36)*, 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); *see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

²*Commissariat A L’Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

³*Haines v. Quigg*, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing *Camp v. Pitts*, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); *Beerly v. Dept. of Treasury*, 768 F.2d 942, 945 (7th Cir. 1985); *Smith v. Mossinghoff*, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁴*Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁵

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”⁶ Nonawareness of a PTO rule will not constitute unavoidable delay.⁷

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner essentially asserts that a clerical and or docketing error resulted the failure to file the formal drawings.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner’s belief that the above-cited application was unavoidably abandoned is not persuasive. The reason petitioner’s argument must necessarily fail is addressed below.

When a clerical error is alleged to be the reason for the delay in responding to an Office action, Section 711.03(c) of the *Manual of Patent Examining Procedure* explains that petitioner must establish that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In this case, petitioner is arguing that a clerical error resulted petitioner’s failure to notice the requirement for formal drawings made in the Notice of Allowability. Petitioner has not established, however, that there was a reliable business routine in place for performing the clerical function, i.e., reading the Notice of Allowability entirely, and did not provide specific

⁵Id.

⁶See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁷See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

information regarding the training and experience of the employee(s) charged with that function.
The petition under 37 CFR 1.137(a) is, therefore, dismissed.


TREATMENT UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is **granted**.

The formal drawings filed November 8, 1999, are noted and made of record.

The application file will be forwarded to the Office of Patent Publications for processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.


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Office of Petitions